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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,315	07/07/2003	Hui-Mei Chen	003-03-014	4257
35870	7590	09/02/2004	EXAMINER	
APEX JURIS, PLLC 13194 EDGEWATER LANE NORTHEAST SEATTLE, WA 98125			HALE, GLORIA M	
		ART UNIT	PAPER NUMBER	
		3765		

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,315	CHEN, HUI-MEI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gloria Hale	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.  
2a)  This action is **FINAL**.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

## DETAILED ACTION

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because the Abstract contains the word "said" and is over 150 words. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: The Specification should be reviewed to ensure that it is in proper idiomatic English such as on page 2, line 11 where "notice" should read - - noticed – and on page 3, lines 5 and 15. On page 6, lines 10-12 it is not clear as to what the reference to the term "Magic Bra" is.

Appropriate correction is required.

Claims 1-9 are objected to because of the following informalities: the recitation "An improved" is the opinion of the applicant and should be removed. In claim 4, line 3 "not stick to each other" is unclear. In claim 8, lines 3-4, the recitation "curve slenderer" is not in proper English. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3 and claim 9, lines 2-3 there is no antecedent basis for the interior or exterior surface. It is not clear as to whether the interior surface is the inner core of the pad or a surface close to the skin of the wearer or if the outer surface is the surface adjacent to the garment or the entire outer surface of the pad on both sides of the pad.

It is also not clear as to whether the pad is claimed in combination with the bra or is just a pad itself for use with a brassiere. It is not clear as to whether both sides of the pad contains adhesive at the same time or just one side as selected during manufacture. In regard to claim 3, line 3 the recitation "other type of padding" is not clear. Also, the placement of the adhesive on the "interior or exterior surfaces" are not structural equivalents and yield different inventive embodiments. In regard to claim 4, line 3 the recitation "will not stick each other" is unclear. In line 6 there is no antecedent basis for "the object". In regard to claims 2, 5 and 6 in regard to the "viscosity" of the polymers it is not clear as to when the polymer has the claimed viscosity. Is it before the "heating and hardening process".

However, the claims as best understood, have been examined on their merits. For applicant's consideration the following case is being cited:

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by -process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 F.2<sup>nd</sup> 695,698, 227 USPQ 964,966 (Fed. Cir. 1985).

Therefore, the method or process of producing the pad including the molding and heating process as claimed in claims 2 and 4-7 have not been given patentable weight.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Furuno et al (US 6,200,195).

In regard to claims 1, 3 and 9 Furuno et al discloses a bra cup padding formed of a flexible silicone padding with a silicone gel film adhesive on the inner surface of the bra padding for attachment to the breast of a wearer as claimed. (See Furuno et al. figure 2 and col. 1, lines 52-63 and col. 2, line 1 – col. 3, line3).

Claims 1,3,8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Prahl (US 4,426,742).

In regard to claims 1, 3, 8 and 9 Prahl discloses a breast padding 10 of silicone material ( col. 4, lines 25-32) with silicone adhesive 51 (col. 4, line 49-58) on the inner surface and wherein the pad has the claimed profile including the thinner part and thicker part as claimed. (See Prahl, figure 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Furuno et al in view of Naestoft et al (US 5071433).

Furuno et al discloses the invention substantially as claimed. However, Furuno et al does not specifically disclose the pad as having the thinner upper part and the thicker lower part. Naestoft et al discloses the pad structure as claimed in order to simulate the breast of a wearer. Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the breast padding of Furuno et al to construct it with the thinner upper part and thicker lower part to better conform to the breast of a wearer wherein the lower area of the breast under the nipple is a thicker portion with a different sloped configuration as seen in figure 2 of Naestoft.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 703-308-1282. The examiner can normally be reached on Tuesday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*gale*  
Gloria Hale  
Primary Examiner  
Art Unit 3765

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